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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,333	08/29/2001	Christopher M. Angelucci	8932-546	7696

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EXAMINER

ROBERT, EDUARDO C

ART UNIT PAPER NUMBER

3732

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/942,333	<b>Applicant(s)</b> ANGELUCCI ET AL.	
	<b>Examiner</b> Eduardo C. Robert	<b>Art Unit</b> 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) 27-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

This application contains claims 27-53 drawn to an invention nonelected with traverse in Paper No. 7 (filed on 9/8/2003). A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 8-11, 16, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Cottle (Reference US Patent “5,888,227” cited in IDS).

Cottle discloses an implant comprising a body portion having a length and configure to be insertable between first and second bone ends (see for example Figures 4-8). The body portion has an outer surface and an inner surface which defines a hollow portion. The body portion also has an inner side region having an inner side length and first and second ends, 11 and 12, which communicates with the hollow portion. The first and second ends 11 and 12

include bone engaging portions having surface projections 18. The bone engaging portions are angled with respect to each other (see Figures 6 and 7). An intersection between the inner side region and the bone engaging portions comprises an angle (see Figures 6 and 7). The outer surface of the implant has a geometric shape, e.g. rectangle (see Figure 7). The projections as saw tooth ridges or pyramidal teeth. Each first and second ends include channel which are capable of accept arms of a distractor (see Figure 4). The body further comprises a plurality of holes or apertures which are capable of receiving suture. The implant can be made from metal or polymer (see col. 48-50).

Claims 1, 2, 4, 5, 7-9, and 12-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Boyle et al. (Reference US Patent "6,277,149" cited in IDS).

Boyle et al. disclose an implant comprising a body portion having a length and configure to be insertable between first and second bone ends (see for example Figures 1-4 and 10-19). The body portion has an outer surface and an inner surface which defines a hollow portion. The body portion also has an inner side region having an inner side length and first and second ends, e.g. 22 and 24, which communicates with the hollow portion. The first and second ends include bone engaging portions having surface projections, e.g. 28. The bone engaging portions are angled with respect to each other (see Figures 1, 3, 9, 10-6, and 18). An intersection between the inner side region and the bone engaging portions comprises an angle. The outer surface of the implant has a geometric shape, e.g. circle, rectangle, oval, etc. (see all Figures). The projections as can be pyramidal teeth shape (see col. 4, lines 26-28). The implant can be made from metal, polymer, bone, or demineralized bone (see col. 4, lines 29-41 and col. 5, lines 17-19).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 6, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyle et al. (Reference US Patent "6,277,149" cited in IDS).

Boyle et al. disclose the claimed invention except for the angle ranging from about 50 to about 70 degrees, the inner side length ranging from about 6 to about 10 mm, the width ranging from about 10.0 to about 11.5 mm and the depth ranging from about 6.5 to about 7.5 or 7.7 mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the implant of Boyle et al. with the angle ranging from about 50 to about 70 degrees, the inner side length ranging from about 6 to about 10 mm, the width ranging from about 10.0 to about 11.5 mm and the depth ranging from about 6.5 to about 7.5 or 7.7 mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

***Response to Arguments***

Applicant's arguments filed on 2/23/04 have been fully considered but they are not persuasive.

In response to applicant's arguments that Cottle and Boyle do not disclose an implant configured to be insertable between first and second bisected bone ends of the spinous process of a single vertebra", it is noted that the statement of intended use and other functional statements do not impose any structural limitations on the claims distinguishable over Cottle and Boyle which are capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The devices have the ability to perform the function if one so desire. Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

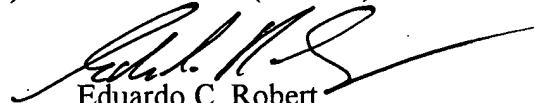
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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo C. Robert whose telephone number is 571-272-4719. The examiner can normally be reached on Monday-Friday, 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on 571-273-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Eduardo C. Robert  
Primary Examiner  
Art Unit 3732

E.C.R.